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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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OCCHIUTI ROHLICEK & TSAO, LLP
10 FAWCETT STREET
CAMBRIDGE, MA 02138

EXAMINER	
STULTZ, JESSICA T	
ART UNIT	PAPER NUMBER
2873	

NOTIFICATION DATE	DELIVERY MODE
11/12/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

INFO@ORTPATENT.COM

Office Action Summary	Application No.	Applicant(s)	
	10/594,937	BEGON ET AL.	
	Examiner	Art Unit	
	JESSICA T. STULTZ	2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 October 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) *18 and 19* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17,20 and 21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *28 September 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *12/5/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I, claims 5-15 and 17 (as well as generic claims 1-4, 16, and 20-21) in the reply filed on October 6, 2008 is acknowledged. The traversal is on the ground(s) that applicant believes that all of claims 5-15 are also generic claims. This is not found persuasive because claims 5-15 specifically describe the species of Figure 4, which is directed to a pair of spectacles. The requirement is still deemed proper and is therefore made FINAL.

Claims 18-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on October 6, 2008.

Claim Objections

Claims 5, 7, and 13 are objected to because of the following informalities. Regarding claim 5, lines 5-6 are repeated on page 4 of the amended claims filed September 28, 2006, these lines should be removed. Additionally, regarding claim 5, the phrase "the first zone" should be changed to "a first zone" since it has not been positively claimed that the element comprises a "first zone". Regarding claim 7, the phrase "said first and second zones" should be changed to "first and second zones", since it has not been positively claimed that the element comprises a "first zone" and a "second zone". Regarding claim 13, the phrase "a fourth zone…the first and second zones…and beneath a third zone" should be changed to "wherein it comprises four zones, specifically wherein the fourth zone…between first and second zones...and beneath a third

zone", since it has not been positively claimed that the element comprises a specific number of zones. Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-2, 5-6, 16-17, and 20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 8, 10-13, and 18-19 of copending Application No. 10/594,604 (cited herein as US 2007/0146574), herein referred to as Giraudet '574. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-2, 5-6, 16-17, and 20 of the instant application are anticipated or made obvious by claims 1, 8, 10-13, and 18-19 of Giraudet '574.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Regarding claim 1, Giraudet '574 discloses a transparent and polarizing vision element divided into several zones, at least two of said zones being associated with a light polarizing filter, the light traversing the element being affected differently for two of said zones according to a direction of polarization of said light (claim 1), the element being characterized in that the polarization filter of at least one of the zones is oriented vertically relative to the position of use of the element (claim 10) and the polarization filter of at least one of said zones is oriented horizontally relative to the position of use of said element (claim 8).

Regarding claim 2, Giraudet '574 discloses the limitations therein (claim 11).

Regarding claim 5, Giraudet '574 discloses the limitations therein (claim 12).

Regarding claim 6, Giraudet '574 discloses the limitations therein (claim 13).

Regarding claims 16 and 20, Giraudet '574 discloses the limitations therein (claim 18).

Regarding claim 17, Giraudet '574 discloses the limitations therein (claim 19).

Claims 1-4, 11, 14, 16, and 20-21 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 13, 15, and 17-18 of copending Application No. 12/067,854 (cited herein as US 2008/0252846), herein referred to as Biver '846. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-4, 11, 14, 16, and 20-21 of the instant application are anticipated or made obvious by claims 13, 15, and 17-18 of Biver '846.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Regarding claim 1, Biver '846 discloses a transparent and polarizing vision element divided into several zones, at least two of said zones being associated with a light polarizing filter, the light traversing the element being affected differently for two of said zones according to a direction of polarization of said light (claims 13/15), the element being characterized in that the polarization filter of at least one of the zones is oriented vertically relative to the position of use of the element (claims 13/15) and the polarization filter of at least one of said zones is oriented horizontally relative to the position of use of said element (claim 13/15).

Regarding claim 2, Giraudet '574 discloses the limitations therein (claims 13/15).

Regarding claim 3, Giraudet '574 discloses the limitations therein (claims 13/15).

Regarding claims 4, 11, 14, Giraudet '574 discloses the limitations therein (claims 17-18).

Regarding claims 16 and 20-21, Giraudet '574 discloses the limitations therein (claims 13/15, wherein the device is an ophthalmic lens).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 7, 16-17, 20-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Heimberger US 3,211,047, herein referred to as Heimberger '047.

Regarding claim 1, Heimberger '047 discloses a transparent and polarizing vision element divided into several zones, at least two of said zones being associated with a light polarizing filter (fields A-D, Column 3, lines 52-68, Figures 1 and 3), the light traversing the element being affected differently for two of said zones according to a direction of polarization of said light (Column 4, lines 28-52, where fields A-D affect light differently), the element being characterized in that the polarization filter of at least one of the zones is oriented vertically relative to the position of use of the element and the polarization filter of at least one of said zones is oriented horizontally relative to the position of use of said element (Column 4, lines 28-52, where fields A and D are oriented vertically and B and C are oriented horizontally, Figures 1 and 3).

Regarding claim 2, Heimberger '047 further discloses that the zone associated with the vertically oriented polarization filter is situated in a lateral portion of the element relative to its position of use (Shown in Figure 1, wherein field D is vertically oriented and located in a lateral portion of the vision element).

Regarding claim 3, Heimberger '047 further discloses that the zone associated with the vertically oriented polarization filter is adjacent to a lateral edge of the element (Shown in Figure 1, wherein field D is vertically oriented and adjacent to a lateral edge of the vision element).

Regarding claim 7, Heimberger '047 further discloses that it comprises first and second zones (A and D, Figure 1), each associated with a polarization filter oriented vertically relative to the position of use of the element (Column 4, lines 28-52) and at least a third zone (B, Figure 1) situated between first and second zones and associated with a horizontally oriented polarization filter (Column 4, lines 28-52).

Regarding claims 16-17 and 20-21, Heimberger '047 discloses a vision device incorporating the at least one transparent vision element, specifically a pair of spectacles, wherein said transparent vision element constituting one lens of said pair of spectacles (Column 4, lines 7-68, wherein the spectacles are shown in Figures 1 and 3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heimberger '047, as applied to independent claim 1 above, in view of Serrell US 2,334,446, herein referred to as Serrell '446.

Regarding claim 4, Heimberger '047 discloses a polarizing vision element as shown above, but does not specifically disclose that one of the zones of said element is associated with

no polarization filter. In the same field of endeavor of polarizing spectacle lenses (Title, Column 1, lines 54-55), Serrell '446 teaches of providing a lens having three different zones (10, 16, 22) with different polarization orientations (Column 1, line 55-Column 2, line 30, Figure 1), specifically wherein one of the zone is unpolarized (Column 1, line 55-Column 2, line 30, wherein segment 22 is unpolarized). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teaching of Serrell '446 with the polarizing vision element of Heimberger '047 for the purpose of reducing road glare on a driver's eyes without moving their head (Column 1, lines 11-17 and Column 2, line 47-Column 3, line 3).

Regarding claim 11, Heimberger '047 discloses a polarizing vision element as shown above including a first zone associated with a polarization filter oriented vertically relative to the position of use of the element and a second zone associated with a horizontally oriented polarization filter (Column 4, lines 28-52, where fields A and D are oriented vertically and B and C are oriented horizontally, Figures 1 and 3), but does not specifically disclose a third unpolarized zone. In the same field of endeavor of polarizing spectacle lenses (Title, Column 1, lines 54-55), Serrell '446 teaches of providing a lens having three different zones (10, 16, 22) with different polarization orientations (Column 1, line 55-Column 2, line 30, Figure 1), specifically wherein one of the zone is unpolarized (Column 1, line 55-Column 2, line 30, wherein segment 22 is unpolarized). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teaching of Serrell '446 with the polarizing vision element of Heimberger '047 for the purpose of reducing road

glare on a driver's eyes without moving their head (Column 1, lines 11-17 and Column 2, line 47-Column 3, line 3).

Regarding claim 12, Heimberger '047 and Serrell '446 disclose and teach of a polarizing vision element as shown above, and Heimberger '047 further discloses that the second zone is positioned in the upper portion of the element relative to its position of use (Figures 1 and 3) and Serrell '446 further teaches that the third zone (22) is positioned in the lower portion of the element relative to its position of use (Figure 1).

Regarding claim 13, Heimberger '047 discloses a polarizing vision element as shown above including a four zones (A-D), wherein the fourth zone (B) is located between the first (A) and second zones (D), but does not disclose that the fourth zone is beneath the third zone (C) and associated with no polarization. In the same field of endeavor of polarizing spectacle lenses (Title, Column 1, lines 54-55), Serrell '446 teaches of providing a lens having three different zones (10, 16, 22) with different polarization orientations (Column 1, line 55-Column 2, line 30, Figure 1), specifically wherein one of the zone is unpolarized (Column 1, line 55-Column 2, line 30, wherein segment 22 is unpolarized) and located below the other two zones (Figure 1). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teaching of Serrell '446 with the polarizing vision element of Heimberger '047 for the purpose of reducing road glare on a driver's eyes without moving their head (Column 1, lines 11-17 and Column 2, line 47-Column 3, line 3).

Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heimberger '047, as applied to independent claim 1 above, in view of Fiala US 5,142,411, herein referred to as Fiala '411.

Regarding claims 5-6, Heimberger '047 discloses a polarizing vision element as shown above, but does not specifically disclose that a first zone associated with a vertically oriented polarization filter extends over a width going from the outer lateral edge of said element to a distance lying between 5 and 75 mm, specifically, between 5 and 30 mm, measured on a straight line going from said outer lateral edge toward the optical center as defined previously of said element. In the same field of endeavor of polarizing spectacle lenses (Abstract), Fiala '411 teaches of providing a lens having at least one horizontally oriented polarization (reading portion 40, Figure 9A) and vertically oriented polarization (distance portion 50, Figure 9A) (Column 21, lines 33-66 and Column 22, lines 30-55), wherein the first (distance, vertically oriented) zone (50) associated with a vertically oriented polarization filter extends over a width going from the outer lateral edge of said element to a distance lying between 5 and 75 mm, specifically, between 5 and 30 mm, measured on a straight line going from said outer lateral edge toward the optical center as defined previously of said element (Column 15, lines 24-36, wherein the radius of the lens ranges between 7.85 to 7.8 mm and portion 50 covers the entire lens and thereby fulfills the claim requirements, Figure 9A). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teaching of Fiala '411 with the polarizing vision element of Heimberger '047 for the purpose of providing cosmetically pleasing glasses that reduce the effects of polarized light (Column 21, line 33-Column 22, line 55).

Claims 8-10 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heimberger '047, as applied to independent claim 1 above.

Regarding claims 8-10, Heimberger '047 discloses a polarizing vision element as shown above, but does not specifically disclose the dimensions of the lens or that the first and second

zones are separated by a distance lying between 10 and 60 mm, specifically between 10 and 40 mm, more specifically between 20 and 40 mm, in a central portion of said element. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made for the device of Heimberger '047 to satisfy the claimed dimensions for the purpose of providing more than two polarization zones on the lens, since it has been held that where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. *In re Gardner v. Tec Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984).

Regarding claims 14-15, Heimberger '047 discloses a polarizing vision element as shown above, but does not specifically disclose that the limit, between the zone associated with a horizontally oriented polarization filter and the zone associated with no polarization filter, passes between the optical center of said element and a point situated 20 mm beneath said optical center, more specifically, between the optical center and a point situated 10 mm beneath said optical center. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made for the device of Heimberger '047 to satisfy the claimed dimensions for the purpose of providing multiple polarization zones on a lens, since it has been held that where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. *In re Gardner v. Tec Systems, Inc.*, 725 F.2d 1338, 220 USPQ

777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Helpern et al US 2005/0099588 and Schwarz US 3,838,913 are cited as having some similar structure to the claimed invention since they disclose vision devices with different polarization zones.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JESSICA T. STULTZ whose telephone number is (571)272-2339. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Mack can be reached on 571-272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jessica T Stultz
Primary Examiner
Art Unit 2873

/Jessica T Stultz/
Primary Examiner, Art Unit 2873